UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARCILLE F. RUMAN, LINDSAY C. SHELLEY,
and KATHLEEN I. RATLIFF

Appeal 2007-2292
Application 10/038,796
Technology Center 3700

Decided: July 27, 2007

Before BRADLEY R. GARRIS, CHARLES F. WARREN, and
PETER F. KRATZ, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on an appeal from the Examiner's non-final rejection of claims 17-19, 25, 27, 30, and 31, the only claims that remain pending in this application. Application claims have been twice rejected. We have jurisdiction pursuant to 35 U.S.C. §§ 6 and 134.

Appellants present an invention directed to a method for securing engagement of hook and loop fastener components of a personal wear article such as a diaper or incontinence garment. Appellants indicate that common

forms of prior art fasteners for such items include hook and loop fastening systems wherein the loop is typically not stretchable (Specification 1). Appellants point out that such prior art hook and loop fasteners tend to disengage when the wearer of such a secured garment is active (Specification 2). Appellants allege overcoming such disengaging problems by employing a hook and loop fastening system wherein the loop material is stretchable and such that the loop is contracted on the hook in using the fastener (id.). Claim 25 is illustrative and reproduced below:

25. A method for securing engagement between fastening components of an article used for personal wear, the fastening components comprising a hook component and a loop component, the loop component comprising a stretchable loop material secured to a stretchable substrate, the hook component being capable of fastening engagement with the loop material of the loop component, the method comprising the steps of:

arranging the fastening components in at least partially opposed relationship with each other;

engaging the fastening components with each other to define an engagement seam whereby the hook component fastenably engages the loop material of the loop component; and

contracting said loop component relative to said hook component at said engagement seam following engagement of the fastening components to thereby urge sliding movement of one fastening component relative to the other fastening component at the engagement seam to promote increased engagement between the fastening components at the engagement seam, said contracting including contracting of said stretchable loop material and contracting of said stretchable substrate.

The Examiner relies on the following prior art references as evidence in rejecting the appealed claims:

Shytles	US 5,125,246	Jun. 30, 1992
Kuen	US 5,386,595	Feb. 7, 1995
Sommers	US 5,693,401	Dec. 2, 1997

Claims 17-19, 25, 27, 30 and 31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kuen. Claims 25 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sommers.

We refer to the Briefs and the Answer for a complete exposition of the respective positions of the Appellants and the Examiner. We affirm the Examiner's anticipation rejection; however, we reverse the Examiner's obviousness rejection. Our reasoning follows.

§ 102(b) Rejection over Kuen

Appellants argue claims 25, 27, and 30 separately. Dependent claims 17-19 and 31 depend from claim 30 and are grouped together therewith. Thus, we select claim 30 as the representative claim on which we decide this appeal for rejected claims 17-19, 30, and 31, which grouping of claims are argued together.

Independent claim 25 is drawn to a method for securing the engagement of personal wear article fastening components including arranging, engaging, and contracting steps relative thereto.

Appellants do not contend that Kuen fails to describe, at least implicitly, arranging, and engaging method steps for the fastening components thereof during the donning/wearing of a fastenable wear article, which arranging and engaging steps of Kuen substantially correspond to the arranging and engaging steps of appealed claim 25. Indeed, like Appellants, Kuen discloses, *inter alia*, hook, and loop type fastening components used with wearable articles for securing the garment in place on a wearer (Kuen;

Abstract, Background, and Summary of the Invention Sections). The wearable items include disposable absorbent garments such as adult incontinence wear, training pants, diapers, and other personal clothing items (Kuen, col. 1, ll. 8-27 and col. 4, ll. 14-21).

Rather, Appellants maintain that Kuen does not disclose, explicitly or implicitly, "a method including contracting a loop component relative to a hook component **at the engagement seam, following engagement** of the fastening components to promote increased engagement between the fastening components" (Br. 6-7).

Kuen, however, describes an embodiment wherein elastic strap members are utilized with the loops formed as part thereof; that is, on a face of each strap member or on opposite faces thereof. (Kuen, col. 14, ll. 29-58). With regard to this third embodiment of Kuen, the Examiner has found that the loop component of Kuen, including the loop material and substrate associated with the loops, are disclosed as being "capable of elastic stretch and retraction" based on the materials and manner of construction thereof (Answer 4; Kuen, col. 14, ll. 29-58, Fig. 7).

While Appellants generally assert that Kuen does not disclose both a stretchable loop material and a stretchable substrate (Br. 8), Appellants do not specifically address the Examiner's reliance on the disclosure at column 14, lines 48-58 of Kuen, including the referenced Shelby Elastics material and the referenced U.S. Patent No. 5,125,246 for a description of these features in Kuen. As such, we agree with the undisputed determination of the Examiner that the referred to portion of the disclosure in Kuen describes

that the loops and substrate of the third embodiment of Kuen are constructed so as to be both stretchable and retractable.

In light of our above-noted finding as to the stretchable/retractable characteristic associated with the loop material and elastic substrate of the third embodiment of Kuen, we agree with the Examiner that Kuen implicitly describes a method step corresponding to the claimed contracting step including contracting a loop component relative to a hook component following engagement of the fastening components at an engagement seam wherein the contracting includes contracting of the stretchable loop material and stretchable substrate. This is so because the normal and usual putting on or wearing of a wearable article having the fastening components as described for the third embodiment article of Kuen will necessarily result in the brought together fastening components, including the stretchable and retractable loop material and strap, being subjected to varying tensions in such putting on and wearing of the article that results in the elongation and contraction of these stretchable/retractable components after the engagement thereof. In this regard, a prior art reference can anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it. *See In re Oelrich,* 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates. *See In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. Artisans of ordinary

skill may not recognize the inherent characteristics or functioning of the prior art. *See id.*, 801 F.2d at 1326, 231 USPQ at 138.

Thus, it is of no import whether or not Kuen appreciated the results of using such a stretchable/contractable loop material and substrate so long as the use thereof in a wearable article fastener would have resulted in the claimed retraction occurring during the normal use thereof as a wearable article. *See W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983).

In light of the above, Appellants' arguments with respect to other portions of the Kuen disclosure and whether or not these other portions of the disclosure of Kuen would have explicitly or inherently disclosed the argued claimed method step are unavailing (Brief 5-9).

Claim 27

Appellants maintain substantially the same arguments against the Examiner's anticipation rejection of dependent claim 27 as they do for independent claim 25 with the same result. Also, Appellants assert that Kuen does not disclose stretching of the loop material prior to engagement followed by the subsequent retraction of the loop material after engagement, as required by claim 27.

We do not consider this additional argument persuasive in that the normal usage of the third embodiment wearable article of Kuen would have necessarily included stretching the elastic strap including the expansible loop material of Kuen in the process of securing the straps and loops thereof to the hooks on the body of the garment during the donning of the article on a wearer. In this regard, Appellants' corollary contention that the Examiner

has not explained the substrate and loop material with respect to the Figure 7 embodiment of Kuen is unpersuasive as the Examiner has pointed to specific portions of column 14 of Kuen in the Answer without any specific rejoinder thereto by Appellants in the Briefs. Consequently, Appellants have not identified any reversible error in the Examiner's anticipation position as set forth in the Answer.

Representative Claim 30

Appellants make substantially the same unpersuasive arguments against the Examiner's rejection of claim 30 as presented against the Examiner's rejection of claims 25 and 27. With respect to representative claim 30, Appellants focus on that claim's requirement for stretching/retracting both the loop material and substrate of the loop component and assert that the Figure 7 embodiment of Kuen does not have a loop material and substrate. For reasons set forth above, we disagree with Appellants' assertions concerning the absence of both loops and a substrate in the third (Figure 7) embodiment of Kuen and with the argument depending thereon; that is, the argument that Kuen does not stretch and contract (retract) the loop material and substrate (strap) in the donning and wearing of a wearable article made in accordance therewith.

As a final point, we note that Appellants' Reply Brief does not furnish any further argument against the Examiner's anticipation position, as set forth in the Answer.

It follows that, on this record, we shall sustain the Examiner's anticipation rejection of claims 17-19, 25, 27, and 30.[1]

§ 103(a) Rejection over Sommers

The Examiner bears the initial burden, on review of prior art or on any other ground, of presenting a prima facie case of unpatentability. *In re Oetiker,* 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Sommers discloses a surgical glove retainer comprising an elastic strip having a first surface with an area of loops near one end and a second surface having an area of hooks near a second end (Sommers, col. 3, ll. 10-25; Fig's. 1 and 2). The Examiner takes the position that Sommers does not disclose contraction of the loop component at the seam and disavows reliance on an inherency theory in rejecting the claimed method (Answer 5 and 9). In this regard, the Examiner asserts that

> "to attach the ends of the elastic strip of Sommers under tension by stretching the one end including the loop component, bringing it into engaging contact with the other end to form a seam and releasing the one end so that the one end, i.e. loop component, at the seam retracts/contracts, if not already, would be obvious to one of ordinary skill in the art in view of the well known interchangeability of methods of attachment"
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> (Answer 5).

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[1] In the event of further prosecution of this subject matter before the Examiner, the Examiner should again review Appellants' Specification for the specific details of how the loops themselves are expanded/contracted and redetermine whether Appellants have furnished a satisfactory descriptive and/or enabling disclosure in accordance with § 112, paragraph 1 for the method, as claimed. This is especially so, in light of Appellants' unsupported assertions about the location where pulling is applied (Br. 7) as seemingly having a significant affect on whether the contraction of the loop is being performed.

We will not sustain the Examiner's § 103 rejection because the obviousness position advanced by the Examiner on this appeal is not persuasive in discharging the burden of the Examiner to present a prima facie case of obviousness. This is, in part, because the Examiner has not fairly articulated where Sommers teaches or suggests a loop component comprising both a stretchable/contractable substrate and a stretchable/contractable loop material being contracted in a manner corresponding to the contraction of these loop component elements as required by the contracting step of claim 25 (Br. 12-13).

Here, the Examiner has not fairly indicated how Sommers' conventional loop material attached to the strip or, in the alternative, the loopy elastic strip material of Sommers would have been used to perform the claimed contracting method step (see Sommers, col. 7, ll. 3-15). As we noted above, the Examiner has expressly disavowed reliance on an inherency theory. However, the Examiner has not furnished any additional evidence to show how the loops would be formed with the strip material of Sommers by one of ordinary skill in the art such that the claimed method would have been obvious within the meaning of § 103.

Even if we take the loop component as a surface of a stretch bonded laminate as was posited by the Examiner (Answer 5), the rejection remains unclear because the Examiner does not articulate how one of ordinary skill in the art would provide such a surface that would constitute both a stretchable loop material and a stretchable substrate, with both contracting, in a manner corresponding to appealed claim 25. In this regard, Sommers

discloses that the elastic strip material includes both non-elastic outer layers and an inner elastic layer in a stretch laminate (Sommers, col. 9, ll. 8-12).

On this record, we fail to see how the Examiner's interchangeability of methods of attachment theory establishes that one of ordinary skill in the art would conclude that securing the hook and loop elements of the surgical glove retainer of Sommers would have obviously involved a contracting of a loop component step performed in the manner required by the claimed subject matter. Rejections based on § 103(a) must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). In this regard, a rationale basis for the rejection must be presented. *See KSR Int'l. Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007).

CONCLUSION

On this record, the decision of the Examiner to reject claims 17-19, 25, 27, and 30 under 35 U.S.C. § 102(b) as being anticipated by Kuen is affirmed, and the decision of the Examiner to reject claims 25 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Sommers is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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